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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,259	04/23/2002	George R. Newkome	0152.00427	9419
48924	7590	04/21/2006	EXAMINER	
SHIBUYA, MARK LANCE				
ART UNIT		PAPER NUMBER		
1639				

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/049,259	NEWKOME, GEORGE R.
	<b>Examiner</b>	<b>Art Unit</b>
	Mark L. Shibuya	1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 4 and 5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. Claims 4 and 5 are pending and are examined.
2. The applicant's Reply, entered 1/23/2006, has been considered. Rejections and/or objections not reiterated from the Final Rejection, mailed 7/21/2005, are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/23/2006 has been entered.

***Priority***

4. The present application is the National Stage, under 35 U.S.C. 371, of PCT/US00/40431, filed July 20, 2000, which claims the benefit of United States Provisional Patent Application Serial No. 60/145,785, filed July 27, 1999, and is also a

continuation-in-part of United States Patent Application of 09/646,737, filed November 22, 2000, which claims benefit of United States Provisional Patent Application No. 60/079,413, filed March 26, 1998, all of which are incorporated herein by reference.

***Drawings***

5. Applicant's filing, on 9/21/2005, of the replacement drawing sheets depicting Figures 3, 4 and 5, is acknowledged.

***Specification***

6. The amendment to the first line of the specification, making specific reference to earlier filed applications, is objected to because the word "Stage" is misspelled as "State".

7. In view of the difficulties in evaluating the hand drawn formulas found on pages 5 and 6, the specification was objected to in the previous Office action, particularly as regarding to those hand drawn formulas. Correction was required.

However, the amendments, filed 9/21/2005, replacing the hand drawn formulae, are objected to under 35 U.S.C. 132(a) because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant has amended the specification at p. 3, to insert an amended compound formula; and to amend the end range value of the integer  $x$  from 3 to 4. Applicant, in the Reply, entered 9/21/2005, at p. 9, para 4, stated that support for these amendments to the specification could be found "in the various examples and in particular in Figure 2 (Formula 22)". However, upon close inspection, Formula 22 as shown in Figure 2, does not depict the aforementioned amended formula.

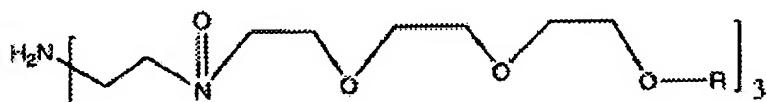
Applicant has amended the formula found on p. 8 of the specification; however, applicant has *not* indicated where specific support for the amendment may be found in the specification as filed.

Applicant must point, with particularity, as to where support for the proposed amendments may be found in the specification as filed.

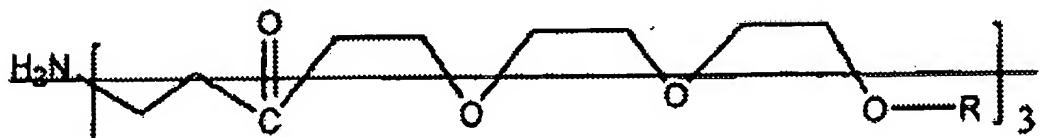
Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

8. It is noted that the amendment to claim 4 inaccurately depicts striking the formula, shown below, and in the previous claim 4:



as



9. Claim 4 states the term "pentaerythitol", which appears to be a misspelling of the recited term "pentaerythritol".

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is for new matter.

Claim 4 now states the terms "nitrotri (acid chloride)" "pentaerythitol", "acrylonitrile", "nitrile hydrolysis", all of which said terms do not appear to find support in the specification as filed. Applicant must point, with particularity, as to where the support for the amendments may be found in the specification as filed.

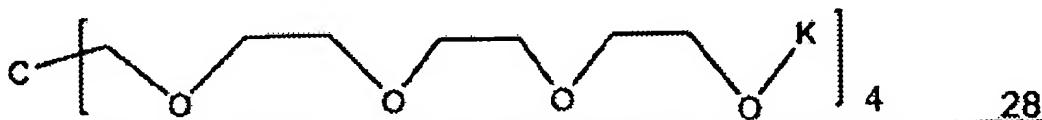
12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 states the language "dendrimer 33", which renders the claim vague and indefinite because it is unclear what "dendrimer 33" is.

Claim 5 depicts the formula



which renders the claim vague and indefinite, because it is unclear what "28" stands for.

Claim 5 recites the limitation "deprotecting an acetyl moiety" in line 11, which renders the claim vague and indefinite, because it is unclear what "acetyl moiety" is deprotected. Furthermore, claim 5 then recites the language "transforming the moiety to a mesylate", which further renders the claim vague and indefinite because it is unclear whether that which is transformed to "a mesylate", is also the "the corresponding mesylate" and "the mesylate", recited in lines 7 and 8, respectively. Thus claim 5 recites terms of uncertain antecedent bases.

### ***Conclusion***

14. Claims 4 and 5 are rejected.

15. Claims 4 and 5 are free of the prior art.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mark L. Shibuya  
Examiner  
Art Unit 1639

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